

Agilent Ref: 10004415-1
United States Application Serial No. 09/740,660

REMARKS

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1-5, 10, 13-21, 23-25, 27, and 32-35- and 37-49, as well as newly introduced Claim 50, the only claims pending and currently under examination in this application.

Formal Matters

Claim 36 and been cancelled and the dependency of Claim 37 has been changed to depend on Claim 1, in view of the previous amendment to Claim 1 limiting the nature of the fluorescent molecule. In addition, Claim 1 has been amended to specify that the protection layer is capable of excluding small molecules, support for this amendment being found in the specification at page 8, line 21. Claim 50 finds support in the specification at, among other locations, page 9, line 4. As, no new matter has been added by the above amendments, their entry by the Examiner is respectfully requested.

Rejection under 35 U.S.C. § 112, second paragraph

In the Advisory Action, the Examiner indicated that the above cancellation of Claim 36 and amendment of the dependency of Claim 37 would overcome the remaining rejections under 35 U.S.C § 112. In view of these amendments, this rejection may be withdrawn.

Rejection under 35 U.S.C. § 102(b)

Claims 1-5, 8, 15-19, 21, 25, 27 and 32-39 and 47 continue to be rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,372,745. Claim 1 has been amended to include the limitation that the protection layer is capable of excluding small molecules.¹

¹ It is noted that this amendment has been made solely in order to expedite prosecution of the present application and without in any way agreeing with the position of the Examiner. The Applicants reserve the right to pursue claims of the scope prior to this amendment in a continuation application.

Agilent Ref: 10004415-1
United States Application Serial No. 09/740,660

It must first be noted that U.S. Patent No. 4,372,745 never teaches a composition of matter having the claimed structure, where a matrix is coated with a layer that includes an organometallic compound, which structure is then further coated with a protective layer. U.S. Patent No. 4,372,745 fails to teach such a composition for at least the reason that the dye in the cited Example XX is not an organo metallic matrix. As such, for at least this reason U.S. Patent No. 4,372,745 fails to anticipate the claimed invention.

Furthermore, U.S. Patent No. 4,372,745 lists a multitude of different types and classes of compounds, with organometallic complexes being only one type of a numerous number of these different types and classes of fluorescent compounds. In addition, there are numerous different structures disclosed in 4,372,745, only one of which is the structure taught in Example XX. For example, other disclosed structures include a solution of a fluorescent compound encased in a liposome.

As such, to arrive at the invention claimed in the present application, one would have to pick and choose among the multitude of different types of dyes and the multitude of different structures to arrive at the claimed invention, without having any specific motivation to do so. In the absence of providing this specific motivation, U.S. Patent No. 4,372,745 further fails to anticipate the claimed invention.

Furthermore, nowhere in U.S. Patent No. 4,372,745 is it taught that the protection layer is one that excludes small molecules. Accordingly, this limitation of the claims further distinguishes the claimed invention over this cited reference.

Therefore, Claims 1-5, 8, 15-19, 21, 25, 27 and 32-39 and 47 are not anticipated by U.S. Patent No. 4,372,745 under 35 U.S.C. § 102(b) and this rejection may be withdrawn.

Finally, Claims 1-5, 8, 15-19, 21, 25, 27 and 32-39 and 47 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No.

Agilent Ref: 10004415-1
United States Application Serial No. 09/740,660

6,528,165. Upon review of the cited reference, it is not seen where the cited reference specifically discloses organometallic complexes as fluorescent dyes in a structure as claimed in the present application, as reviewed above. While a large number of different types of dyes are disclosed in this cited reference, there is no specific structure seen that matches the structure as claimed in the present application. As such, the cited reference fails to anticipate the claimed subject matter and this rejection may be withdrawn.

Agilent Ref: 10004415-1
United States Application Serial No. 09/740,660

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,
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By: _____


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